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EXAMINER

HONG, WILLIAM

ART UNIT

PAPER NUMBER

3725

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Art Unit: 3725

DETAILED ACTION

The amendment filed June 2, 2003, does not comply with MPEP 1453. A copy of MPEP is enclosed herewith for the convenience of the Applicant. Specifically, the amendment to the specification is improper because the "marked up copy" is improperly marked since the rules (37CFR 1.173(b)(1) and 1.173(d)(1)) require the use of brackets, not strikethroughs in the text. Since the above-mentioned reply appears to be *bona fide*, the THREE (3) MONTH SHORTEN STATUTORY PERIOD is reset from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Please be advised that new amendment rules (37 CFR 1.121) specifically do not apply to reissue applications, and that there is no clean copy/marked up copy practice in reissue applications. Any future amendments that do not comply with the regulations will result in a holding that the amendment is not a *bona fide* attempt.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Hong whose telephone number is 703-308-9619. The examiner can normally be reached on Mon-Thu, 8:00a-6:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Art Unit: 3725

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.

A handwritten signature in black ink, appearing to read 'William Hong', with a stylized flourish at the end.

William Hong
Primary Examiner
Art Unit 3725

September 4, 2003

CONTINUATION REISSUE APPLICATIONS

A continuation of a reissue is not ordinarily filed “for distinct and separate parts of the thing patented” as called for in the second paragraph of 35 U.S.C. 251. The decision of *In re Graff*, 111 F.3d 874, 42 USPQ2d 1471 (Fed. Cir. 1997) interprets 35 U.S.C. 251 to permit multiple reissue patents to issue even where the multiple reissue patents are not for “distinct and separate parts of the thing patented.” The court stated:

Section 251[2] is plainly intended as enabling, not as limiting. Section 251[2] has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications, by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding. Thus § 251[2] places no greater burden on Mr. Graff’s continuation reissue application than upon a continuation of an original application; § 251[2] neither overrides, enlarges, nor limits the statement in § 251[3] that the provisions of Title 5 apply to reissues.

111 F.3d at 877, 42 USPQ2d at 1473. Accordingly, prosecution of a continuation of a reissue application will be permitted (despite the existence of the pending parent reissue application) where the continuation complies with the rules for reissue.

The parent and the continuation reissue applications should be examined together if possible. An appropriate amendment to the continuing data entries must be made to the first sentence of the specification, (see the discussion above under the heading “Divisional Reissue Applications”), and to the bibliographic data sheet reprint (for 09/ and later series) or to the front face of the reissue file wrapper (for 08/ and earlier series), for *both the parent and the continuation* reissue applications, so that the parent-continuation relationship of the reissue applications is specifically identified and notice is provided of both reissue applications.

Where the parent reissue application issues prior to the examination of the continuation, the claims of the continuation should be carefully reviewed for double patenting over the claims of the parent. Where the parent and the continuation reissue applications are

examined together, a provisional double patenting rejection should be made in both cases as to any overlapping claims. See MPEP § 804 - § 804.04 as to double patenting rejections. Any terminal disclaimer filed to obviate an obviousness-type double patenting rejection ensures common ownership of the reissue patents throughout the remainder of the unexpired term of the original patent.

If the parent reissue application issues without any cross reference to the continuation, amendment of the parent reissue patent to include a cross-reference to the continuation must be effected at the time of allowance of the continuation application by Certificate of Correction. See the discussion above under the heading “Divisional Reissue Applications” as to how the Certificate of Correction is to be provided.

1452 Request for Continued Examination of Reissue Application

A request for continued examination (RCE) under 37 CFR 1.114 is available for a reissue application. Effective May 29, 2000, an applicant in a reissue application may file a request for continued examination of the reissue application, if the reissue application was filed on or after June 8, 1995. This applies even where the application, which resulted in the original patent, was filed prior to June 8, 1995.

An RCE continues the prosecution of the existing reissue application and is not a filing of a new reissue application. Thus, the filing of an RCE will not be announced in the *Official Gazette*. Additionally, if a reissue application is merged with a reexamination proceeding (see MPEP § 1449.01), the filing of an RCE will not dissolve the merger, since the reissue application does not become abandoned.

1453 Amendments to Reissue Applications

37 CFR 1.121. *Manner of making amendments in application.*

(h) *Amendments in reissue applications.* Any amendment to the description and claims in reissue applications must be made in accordance with § 1.173.

37 CFR 1.173. Reissue specification, drawings, and amendments.

(b) *Making amendments in a reissue application.* An amendment in a reissue application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made.

(1) *Specification other than the claims.* Changes to the specification, other than to the claims, must be made by submission of the entire text of an added or rewritten paragraph, including markings pursuant to paragraph (d) of this section, except that an entire paragraph may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. The precise point in the specification must be identified where any added or rewritten paragraph is located. This paragraph applies whether the amendment is submitted on paper or compact disc (see §§ 1.52(e)(1) and 1.821(c), but not for discs submitted under § 1.821(e)).

(2) *Claims.* An amendment paper must include the entire text of each claim being changed by such amendment paper and of each claim being added by such amendment paper. For any claim changed by the amendment paper, a parenthetical expression "amended," "twice amended," *etc.*, should follow the claim number. Each changed patent claim and each added claim must include markings pursuant to paragraph (d) of this section, except that a patent claim or added claim should be canceled by a statement canceling the claim without presentation of the text of the claim.

(3) *Drawings.* Any change to the patent drawings must be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new drawings in compliance with § 1.84 including the approved changes must be filed. Amended figures must be identified as "Amended," and any added figure must be identified as "New." In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled."

(c) *Status of claims and support for claim changes.* Whenever there is an amendment to the claims pursuant to paragraph (b) of this section, there must also be supplied, on pages separate from the pages containing the changes, the status (*i.e.*, pending or canceled), as of the date of the amendment, of all patent claims and of all added claims, and an explanation of the support in the disclosure of the patent for the changes made to the claims.

(d) *Changes shown by markings.* Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings:

(1) The matter to be omitted by reissue must be enclosed in brackets; and

(2) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (§§ 1.96 and 1.821(c)). Matter added by reissue on compact discs must be preceded with "<U>" and end with "</U>" to properly identify the material being added.

(e) *Numbering of patent claims preserved.* Patent claims may not be renumbered. The numbering of any claim added in the reissue application must follow the number of the highest numbered patent claim.

(f) *Amendment of disclosure may be required.* The disclosure must be amended, when required by the Office, to correct inaccuracies of description and definition, and to secure substantial correspondence between the claims, the remainder of the specification, and the drawings.

(g) *Amendments made relative to the patent.* All amendments must be made relative to the patent specification, including the claims, and drawings, which are in effect as of the date of filing of the reissue application.

The provisions of 37 CFR 1.173(b)-(g) and those of 37 CFR 1.121(h) apply to amendments in reissue applications. Any amendments submitted in a reissue application on or after March 1, 2001, must comply with 37 CFR 1.173(b) (see 37 CFR 1.121(h)).

Amendments filed prior to March 1, 2001, in compliance with former 37 CFR 1.121(b) (prior to the revision of the rule in the Patent Business Goals final rule) will be accepted. On or after March 1, 2001, amendments submitted in a reissue application must comply with 37 CFR 1.173(b). Accordingly, amendments submitted before March 1, 2001, under the prior practice need not, and should not, be re-submitted under the current practice. However, if such an amendment *is in fact re-submitted*, it will be entered, unless non-entry is directed or approved by the Supervisory Patent Examiner (SPE) or the Technology Center Special Program Examiner (SPRE).

Amendments submitted in a reissue application, including preliminary amendments (*i.e.*, amendments filed as a separate paper to accompany the filing of a reissue application), must comply with the practice outlined below in this section; however, for examiner's amendments to the specification and claims, 37 CFR 1.121(g) provides certain exceptions to that practice in the interest of expediting prosecution. The exceptions set forth in 37 CFR 1.121(g) also apply in reissue applications.

Pursuant to 37 CFR 1.173(a), no amendment in a reissue application may enlarge the scope of the claims, unless "applied for within two years from the grant of the original patent." Further, the amendment may not introduce new matter. See MPEP § 1412.03

for further discussion as to the time limitation on enlarging the scope of the patent claims in a reissue application.

All amendment changes must be made relative to the patent to be reissued. Pursuant to 37 CFR 1.173(d), any such changes which are made to the specification, including the claims, must be shown by employing the following "markings:"

(A) The matter to be omitted by reissue must be enclosed in brackets; and

(B) The matter to be added by reissue must be underlined, except for amendments submitted on compact discs (pursuant to 37 CFR 1.96 for computer printouts or programs, and 37 CFR 1.825 for sequence listings). Matter added by reissue on compact discs must be preceded with "<U>" and end with "<U>" to properly identify the material being added.

THE SPECIFICATION

37 CFR 1.173(b)(1) relates to the manner of making amendments to the specification other than the claims. It is not to be used for making amendments to the claims or the drawings.

All amendments which include any deletions or additions must be made by submission of the entire text of each added or rewritten paragraph with markings (as defined above), except that an entire paragraph of specification text may be deleted by a statement deleting the paragraph without presentation of the text of the paragraph. Applicant must indicate the precise point where each amendment is made. All bracketing and underlining is made in comparison to the original patent, not in comparison to any prior amendment in the reissue application. Thus, all paragraphs which are newly *added* to the specification of the original patent must be submitted as completely underlined each time they are re-submitted in the reissue application.

THE CLAIMS

37 CFR 1.173(b)(2) relates to the manner of making amendments to the claims in reissue applications. It is not to be used for making amendments to the remainder of the specification or to the drawings. 37 CFR 1.173(b)(2) requires that:

(A) For each claim that is being amended by the amendment being submitted (the current amendment),

the entire text of the claim must be presented with markings as defined above;

(B) For each new claim added to the reissue by the amendment being submitted (the current amendment), the entire text of the added claim must be presented completely underlined;

(C) A patent claim should be canceled by a direction to cancel that claim, there is no need to present the patent claim surrounded by brackets; and

(D) A new claim (previously added in the reissue) should be canceled by a direction to cancel that claim.

Original patent claims are never to be renumbered; see 37 CFR 1.173(e). A patent claim retains its number even if it is canceled in the reissue proceeding, and the numbering of any added claims must begin after the last original patent claim.

Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. The status to be set forth is whether the claim is pending or canceled. The failure to submit the claim status will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

Also pursuant to 37 CFR 1.173(c), each claim amendment must be accompanied by an explanation of the support in the disclosure of the patent for the amendment (i.e., support for all changes made in the claim(s), whether insertions or deletions). The failure to submit an explanation will generally result in a notification to applicant that the amendment *prior to final rejection* is not completely responsive (see 37 CFR 1.135(c)). Such an amendment *after final rejection* will not be entered.

THE DRAWINGS

37 CFR 1.173(b)(3) relates to the manner of making amendments to the drawings.

37 CFR 1.173(a)(2), states that amendments to the original patent drawings are not permitted, and that any change to the drawings must be by way of 37 CFR 1.173(b)(3). 37 CFR 1.173(b)(3) requires that any change to the patent drawings be submitted as a sketch on a separate paper showing the proposed changes in red for approval by the examiner. Upon approval by the examiner, new sheets of drawings in compliance with 37 CFR 1.84 including the approved

changes must be filed. The new sheets of drawings must be filed with the amended figures being identified as "amended" and with added figures identified as "new" for each sheet that has changed. In the event that a figure is canceled, the figure must be surrounded by brackets and identified as "Canceled." See also MPEP § 1413 for a further discussion as to the drawings.

Form paragraph 14.20.01 may be used to advise applicant of the proper manner of making amendments in a reissue application.

¶ 14.20.01 Amendments To Reissue-37 CFR 1.173(b)

Applicant is notified that any subsequent amendment to the specification and/or claims must comply with 37 CFR 1.173(b).

Examiner Note:

This form paragraph may be used in the first Office action to advise applicant of the proper manner of making amendments.

Form paragraph 14.21.01 may be used to notify applicant that proposed amendments **filed prior to final rejection** in the reissue application do not comply with 37 CFR 1.173(b).

¶ 14.21.01 Improper Amendment To Reissue - 37 CFR 1.173(b)

The amendment filed [1] proposes amendments to [2] that do not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. A supplemental paper correctly amending the reissue application is required.

A shortened statutory period for reply to this letter is set to expire **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this letter.

Examiner Note:

This form paragraph may be used for any 37 CFR 1.173(b) informality as to an amendment submitted in a reissue application prior to final rejection. After final rejection, applicant should be informed that the amendment will not be entered in an Advisory Office action.

Note that if an informal amendment is submitted **after final rejection**, form paragraph 14.21.01 should not be used. Rather, an advisory Office action should be issued using Form PTO-303 indicating that the amendment was not entered because it does not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications.

ALL CHANGES ARE MADE VIS-À-VIS THE PATENT TO BE REISSUED

When a reissue patent is printed, all underlined matter is printed in *italics* and all brackets are printed

as inserted in the application, in order to show exactly which additions and deletions have been made to the patent being reissued. Therefore, all underlining and bracketing in the reissue application should be made relative to the text of the patent, as follows. In accordance with 37 CFR 1.173(g), all amendments in the reissue application must be made relative to (i.e., *vis-à-vis*) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. If there was a prior change to the patent (made via a prior concluded reexamination certificate, reissue of the patent, certificate of correction, etc.), the first amendment of the subject reissue application must be made relative to the patent specification as changed by the prior proceeding or other mechanism for changing the patent. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment.

The Subject Patent Already Has Underlining or Bracketing

If the original (or previously changed) patent includes a formula or equation already having underlining or bracketing therein as part of the formula or equation, any amendment of such formula or equation should be made by bracketing the entire formula and rewriting and totally underlining the amended formula in the re-presented paragraph of the specification or rewritten claim in which the changed formula or equation appears. Amendments of segments of a formula or equation should not be made. If the original patent includes bracketing and underlining from an earlier reexamination or reissue, double brackets and double underlining should be used in the subject reissue application to identify and distinguish the present changes being made. The subject reissue, when printed, would include double brackets (indicating deletions made in the subject reissue) and boldface type (indicating material added in the subject reissue).

EXAMPLES OF PROPER AMENDMENTS

A substantial number of problems arise in the Office because of improper submission of amendments in reissue applications. The following examples

are provided to assist in preparation of proper amendments to reissue applications.

Original Patent Description or Patent Claim Amended

Example (1)

If it is desired to change the specification at column 4 line 23, to replace "is" with --are--, submit a copy of the entire paragraph of specification of the patent being amended with underlining and bracketing, and point out where the paragraph is located, e.g.,

Replace the paragraph beginning at column 4, line 23 with the following:

Scanning [is] are controlled by clocks which are, in turn, controlled from the display tube line synchronization. The signals resulting from scanning the scope of the character are delivered in parallel, then converted into serial mode through a shift register wherein the shift signal frequency is controlled by a clock that is, in turn, controlled from the display tube line synchronization.

Example (2)

For changes to the claims, one must submit a copy of the entire patent claim with the amendments shown by underlining and bracketing, e.g.,

Amend claim 6 as follows:

Claim 6 (Amended). The apparatus of claim [5] 1 wherein the [first] second piezoelectric element is parallel to the [second] third piezoelectric element.

If the dependency of any original patent claim is to be changed by amendment, it is proper to make that original patent claim dependent upon a later filed higher numbered claim.

Cancellation of Claim(s)

Example (3)

To cancel an original patent claim, in writing, direct cancellation of the patent claim, e.g.,

Cancel claim 6.

Example (4)

To cancel a new claim (previously added in the reissue), in writing, direct cancellation of the new claim, e.g.,

Cancel claim 15.

Presentation of New Claims

Example (5)

Each new claim (i.e., a claim not found in the patent, that is newly presented in the reissue application) should be presented with underlining throughout the claim, e.g.,

Add claim 7 as follows:

Claim 7. The apparatus of claim 5 further comprising electrodes attaching to said opposite faces of the first and second piezoelectric elements.

Even though original claims may have been canceled, the numbering of the original claims does not change. Accordingly, any added claims are numbered beginning with the number next higher than the number of claims in the original patent. If new claims have been added to the reissue application which are later canceled prior to issuance of the reissue patent, the examiner will renumber any remaining new claims in numerical order to follow the number of claims in the original patent.

Amendment of New Claims

An amendment of a "new claim" (i.e., a claim not found in the patent, that was previously presented in the reissue application) must be done by presenting the amended "new claim" containing the amendatory material, and completely underlining the claim. The presentation cannot contain any bracketing or other indication of what was in the previous version of the claim. This is because all changes in the reissue are made *vis-à-vis* the original patent, and not in comparison to the prior amendment. Although the presentation of the amended claim does not contain any indication of what is changed from the previous version of the claim, applicant must point out what is changed in the "Remarks" portion of the amendment. Also, per 37 CFR 1.173(c), each change made in the claim must be accompanied by an explanation of the support in the disclosure of the patent for the change.

Amendment of Original Patent Claims More Than Once

The following illustrates proper claim amendment of original patent claims in reissue applications:

A. Patent claim.

Claim 1. A ~~cutting means~~ having a handle portion and a blade portion.

B. Proper first amendment format.

Claim 1 (Amended). A [cutting means] knife having a bone handle portion and a notched blade portion.

C. Proper second amendment format.

Claim 1 (Twice Amended). A [cutting means] knife having a handle portion and a serrated blade portion.

Note that the second amendment must include the changes previously presented in the first amendment, i.e., [cutting means] knife, as well as the new changes presented in the second amendment, i.e., serrated.

The word bone was presented in the first amendment and is now to be deleted in the second amendment. The word "bone" is NOT to be shown in brackets in the second amendment. Rather, the word "bone" is simply omitted from the claim, since "bone" never appeared in the patent. An explanation of the deletion should appear in the remarks.

The word notched which was presented in the first amendment is replaced by the word serrated in the second amendment. The word notched is being deleted in the second amendment and did not appear in the patent; accordingly, "notched" is not shown in any form in the claim. The word serrated is being added in the second amendment, and accordingly "serrated" is added to the claim and is underlined.

In the second amendment, the deletions of "notched" and "bone" are not changes from the original patent claim text and therefore are not shown in brackets in the second amendment. In both the first and the second amendments, the entire claim is presented only with the changes from the original patent text.

1454 Appeal Brief

The requirements for an appeal brief are set forth in 37 CFR 1.192 and MPEP § 1206, and they apply to a reissue application in the same manner that they apply to a non-reissue application. There is, however, a difference in practice as to presentation of the copy of the claims in the appeal brief for a reissue application. The claims on appeal presented in an appeal brief for a reissue application should include all underlining and bracketing necessary to reflect the changes made

to the patent claims during the prosecution of the reissue application. In addition, any new claims added in the reissue application should be completely underlined.

1455 Allowance and Issue

"BLUE SLIP"

In all reissue applications prepared for issue where a blue slip is needed (i.e., 08/ and earlier series), the patent number of the original patent which is being reissued should be placed in the box provided therefor below the box for the applicant's name on the blue Issue Classification Slip (form PTO-270) or design Issue Classification Slip (form PTO-328). Otherwise, the Issue Classification Slip is prepared in the same manner as for a non-reissue application.

For 09/ and later series applications, the patent number of the original patent which is being reissued should be placed on the face of the file wrapper above the box "PREPARED AND APPROVED FOR ISSUE" just after "(Exr. Initials)" in the line reading "SURRENDER OF ORIGINAL PATENT _____ (Exr. Initials)."

CHANGES TO THE ORIGINAL PATENT

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent text by enclosing any material omitted by the reissue in heavy brackets [] and printing material added by the reissue in *italics*. 37 CFR 1.173 (see MPEP § 1411) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue patent specification will carry the following heading, which will be added by the Publishing Division of the Office of Patent Publication:

"Matter enclosed in heavy brackets [] appears in the original patent but forms no part of this reissue specification; matter printed in *italics* indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Examiners should carefully check the entry of all amendments to ensure that the changes directed by applicant will be accurately printed in any reissue patent that may ultimately issue.